

Remarks

This application is a divisional from the application previously issued as U.S. Patent No. 6,735,604. Claims 26-37 are pending in the application. Applicants have elected without traverse to prosecute the invention of claims 26-33. Claims 26-33 have been rejected on various grounds as more fully discussed and addressed below. Claims 34 and 35 are withdrawn from examination at this time as being drawn to a non-elected invention. New claims 36-38 have been added.

Section 101 Rejection

Claims 26-27 have been rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicants traverse this rejection.

Section 101 of the Patent Statute provides: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. 101. In interpreting this statute, the Supreme Court explained over a quarter century ago that statutory subject matter under Section 101 should be broadly construed: “In choosing such expansive terms as ‘manufacture’ and ‘composition of matter,’ modified by the comprehensive ‘any,’ Congress plainly contemplated that the patent laws would be given wide scope.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (“The repetitive use of the expansive term ‘any’ in § 101 shows Congress’s intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101.”). And quoting from the legislative history for this statute, the Supreme Court in the *Chakrabarty* case further stated: “Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” 447 U.S. at 309 (quoting S. Rep. No. 82-1979, at 5 (1952); H.R. Rep. No. 82-1923, at 6 (1952)); *see also Diamond v. Diehr*, 450 U.S. 175, 182 (1981). Indeed, the only limits that the Supreme Court has specifically identified are three

categories of unpatentable subject matter: “laws of nature, natural phenomena, and abstract ideas.” *Diehr*, 450 U.S. at 185. None of these apply here. To the contrary, there is no question but that rejected claims 26 and 27 each falls within the “process” category of patentable subject matter included in Section 101.

The language used by the Examiner in support of this Section 101 rejection appears to be derived from the PTO’s “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility”, 70 Fed. Reg. 75451 (December 14, 2005). But those Guidelines are based on out-dated case law, and are inconsistent with more recent controlling Federal Circuit authority that has supplanted that older case law. For example, the Examiner requires the production of a “useful, concrete, and tangible *result*”. (Office Action at page 4, emphasis added). But the more recent authority is not so limiting. Indeed, in the *State Street* case, the Federal Circuit made it clear that the focus should be on the “practical utility” of the claimed invention. 149 F.3d at 1375 (“The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to--process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its *practical utility*.”) (emphasis added, footnote omitted). And in a more recent case, the Federal Circuit instructed that the inquiry should be on whether the invention as a whole is applied in a “useful manner”. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (“The *State Street* formulation, that a mathematical algorithm may be an integral part of patentable subject matter such as a machine or process if the claimed invention as a whole is applied in a ‘useful’ manner, follows the approach taken by this court en banc in *In re Alappat*, 33 F.3d 1526, 31 U.S.P.Q.2D (BNA) 1545 (Fed. Cir. 1994).”).

Applying the “practical utility” and “useful manner” standards to claims 26 and 27 leaves no question but that each of these claims recites statutory subject matter. For example, claim 26 is directed to the operation of an electronic switch involving various steps related to the receipt and storage of data objects and the receipt of signals relating to the status of hardware

components. Claim 27 recites similar patentable subject matter. These methods are employed to insure that data is not lost due to overloaded receivers. As such, each of the process claims unquestionably has “practical utility” and is applied in a “useful manner”.

If the Examiner persists in this rejection, Applicants respectfully request that the Examiner identify the features of the invention that would render the claimed subject matter statutory if recited in the claim, in accordance with MPEP 2106(IV)(B).

Section 112 Rejections

Claim 26 is rejected under 35 U.S.C. 112, second paragraph, based upon an inconsistent spelling of “comparator” as compared to “comparitor”. The Examiner is correct in assuming that these terms have the same meaning. Claim 26 has been amended to delete any reference to a comparitor. As such, this rejection should be withdrawn.

Section 103 Rejections

Claims 26 and 27 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Klein in view of Simpson. These rejections are traversed. The fundamental flaw in the Examiner’s reasoning and analysis is confusing a comparitor with a switch. This most likely occurred since it may not be readily apparent which structure in Figure 1B connects with the lines representing data flow leading from the busy transfer switch 12 in Figure 1A. This is most easily seen if Figures 1A and 1B are viewed closely or placed next to one another in side-to-side relationship. Upon close inspection, it is seen that the data flow lines coming from the busy transfer switch 12 in Figure 1A connect with receivers in Figure 1B (i.e., Receiver No. 1 of “N” Rec., Receiver No. 2 of “N” Rec. and Receiver No. 3 of “N” Rec.), not to comparitors. Claims 26 and 27 have been amended in light of this clarification. With this clarification in mind, it should now be apparent that the Examiner’s reliance on Klein and Simpson is misplaced.

Klein says nothing about the operation of a switch, but instead focuses only on a comparator. Additionally, the comparator in Klein is not a receiver as recited in amended claims 26 and 27. In Klein, the comparator is embedded in the core of a computer processor memory circuit, and has a fixed input and a fixed output that process the “string” of bits and bytes for

each line of cache line. (Klein, Figure 7, and col. 13, lines 9-21). This permanently dedicates these chip-mounted comparators to one aspect of the internal computer processor bit stream. Klein's comparator does not function as a switch, and it has no need for a busy signal as in claims 26 and 27 since the comparators are hard-wired and dedicated to one repetitive function. For this reason, Klein does not meet the limitations of claims 26 and 27 as asserted by the Examiner, and Simpson does not overcome this deficiency. As such, it is respectfully submitted that these rejections should be withdrawn, and amended claims 26 and 27 are in condition for allowance, an early notice of which is earnestly solicited.

The Examiner has also rejected claims 28 and 30-33 under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of Simpson. Applicants traverse these rejections. The comparitors relied upon by the Examiner from Hughes are not indexing receivers that index incoming data objects or data receivers that receive indexed data objects when not busy or a document holding file that holds indexed data objects when the data receivers are busy. Nothing in Simpson or elsewhere in Hughes overcomes these deficiencies. As such, it is submitted that these rejections should be withdrawn, and that amended claim 28, and each of its rejected dependent claims, including rejected claim 29 per paragraph 8 of the Office Action, are in condition for allowance, an early notice of which is respectfully requested.

Concluding Remarks

In commenting upon the references and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the references and the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the prior art and the Applicants' present invention have been made by Applicants. For the foregoing reasons, Applicants reserve the right to submit additional evidence showing the distinctions between Applicants' invention to be unobvious in view of the prior art.

The foregoing remarks are intended to assist the Examiner in examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be considered to be exhaustive of the facets of the invention which render it patentable, being only examples of certain advantageous features and differences which Applicants' attorney chooses to mention at this time.

The claims of this application are believed to be in condition for allowance, an early notice of which is earnestly solicited. Applicants respectfully request that the Examiner call Applicants' undersigned counsel should the foregoing Amendment not place this case in condition for allowance. In the event a fee may be required for filing this document, but it is not enclosed, the Commissioner is authorized to charge any such fees to Deposit Account No. 50-2515, Order No. 5466.002/DIV/CDQ.

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Respectfully submitted,



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